

REMARKS/ARGUMENTS

1. In response to the Office Action mailed July 11, 2006, reconsideration of this patent application, in light of the following discussion, is respectfully requested. Claims 1-43 and 80-89 are under consideration. Claims 44-79 and 90-92 are withdrawn.

Applicants are preparing both replacement Figs 1, 3, 4A and 5A and an Information Disclosure Statement for filing with the U.S.P.T.O.

Applicants are currently verifying inventorship in relation to the claim election and will amend the inventorship in accordance with 37 CFR 1.48(b), if necessary.

2. Applicants note with appreciation the Examiner's withdrawal of his objection to the title and his rejection of claims 16 and 89 in view of Applicants' amendments filed on March 30, 2006.

3-5. Applicants also note with appreciation the Examiner's withdrawal of his rejection of claims 27-28, 34, 36-41, 43 and 83 in view of Applicants' arguments also filed on March 30, 2006. However, with regard to the Examiner's new grounds for rejection, those rejections are traversed as set forth herein.

6-7. Applicants note that the pages of Papamichael, K. et al., Product Modeling for Computer-aided Decision Making (1999; Reference B) has been re-numbered by the Examiner to correct the pagination inconsistencies noted by the Applicants in their previous response. The revised pagination by the Examiner is addressed by the Applicants under sections 8-9 *infra* in their response to the anticipation rejections. With regard to the Examiner's arguments set forth within Sections 6-7, Applicants will address the Examiner's arguments as applicable to their

responses to the present claim rejections, *infra*.

8-9. 35 U.S.C §102(b) anticipation rejections (1-2, 7, 13-14, 17-18, 25, 30-31, 33, 42, 82, 84-85 and 89):

Claims 1-2, 7, 13-14, 17-18, 25, 30-31, 33, 42, 82, 84-85 and 89 stand rejected under 35 U.S.C. 35 U.S.C. §102(b) as anticipated by the “Building Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” three published articles, namely, Papamichael et al., Building Design Advisor: Automated Integration of Multiple Simulation Tools (1997) (reference A); Papamichael et al., Product Modeling for Computer-aided Decision Making (1999) (reference B); and Papamichael et al., Application of Information Technologies in Building Design Decisions (1999) (reference C). (Office Action, Section 9)(emphasis added by the Examiner).

I. The rejections of the foregoing claims are unwarranted and traversed where duplicate pages of the reference makes the Examiner’s determination of the publication date of reference B indeterminate such that a proper comparison of the dates of the application and the reference cannot be made in support of anticipation.

Applicants note that the pages of Papamichael, K. et al., Product Modeling for Computer-aided Decision Making (1999; Reference B) have been re-numbered by the Examiner to correct the pagination inconsistencies noted by the Applicants in their previous response. However, Applicants note that, in view of the Examiner’s revised pagination, Reference B appears to set forth more than a single publication whereas the document includes duplicate pages 2-4, with

each set of duplicate pages including respectively different subject matter that allegedly inherently anticipates the Applicants' claims.

In including duplicate pages and possibly setting forth more than a single publication, the Applicants respectfully submit that the Examiner's determination of the publication date(s) of the reference(s) and/or duplicate pages is indeterminate such that a proper date comparison cannot be made between the application and the reference(s) in support of the anticipation rejections of the Applicants' claims. See M.P.E.P. §706.02(a) I.

In view of the foregoing, a withdrawal of the rejection of claim 1, and of claims 2, 7, 13, 14, 17, 18, 25, 30, 31, 82, 84 and 85 as directly or indirectly depending therefrom, is thus respectfully requested. A withdrawal of the rejection of claim 33, and of claims 42 and 89 as directly depending therefrom, is respectfully requested as well. Applicants respectfully request that the Examiner set forth the duplicate pages 2-4 as part of a separate publication reference, providing the reference date associated therewith, and/or provide clarification for the duplicate pages set forth in Reference B.

II. The rejections of the foregoing claims are unwarranted and thus traversed where the Examiner has set forth three separate references as inherently disclosing characteristics of the claimed invention without properly citing a primary patent or printed publication reference that allegedly teaches the inherent characteristics or that provides a reference date for comparison with that of the Applicant's claimed invention; where the software version of the primary reference is indeterminate; where no proper

basis in fact or technical reasoning of inherency is provided; and where no proper incorporation by reference is present.

A. The Anticipation Rejections are Improper because No Proper Primary Patent or Printed Publication Reference is Cited in Support of Using Multiple References A, B and C to Show the Allegedly Inherent Characteristics

As noted by the Examiner in Section 7 of the present Action, Sub-section III. of M.P.E.P. §2131.01 permits the use of multiple references in support of anticipation rejections to show that a characteristic not disclosed in the reference is inherent, with such evidence used to show an inherent characteristic of a primary reference. In support of using an inherency basis to set forth multiple references in an anticipation rejection, of the Examiner refers to the claims as being “anticipated by the Building Design Advisor (BDA) software system product, a single software system and method . . . wherein each of the supporting references expressly teach . . . characteristics inherent in the Building Design Advisor software product.” (Office Action, Section 7, pp. 7-8).

The Examiner thus appears to refer to the Building Design Advisor *software product itself* as the primary reference, with the Papamichael et al. articles (i.e. References A, B and C) each disclosing allegedly inherent characteristics of the software. However, the Applicants respectfully submit that the “Building Design Advisor software product” is not a proper primary reference under 35 U.S.C. 102(b) wherein the statute recognizes only the *patents or printed publications disclosing the prior art invention* - not the product itself, as a prior art reference. As recited by the M.P.E.P.:

Application. No. 09/788,470
Response to Office Action of July 11, 2006

The examiner, having obtained a thorough understanding of the invention disclosed and claimed in the nonprovisional application, then searches the prior art as disclosed in the patents and other published documents, i.e. nonpatent literature (NPL). *Any document used in the rejection of a claim is called a reference.*

See M.P.E.P., Section §904(emphasis added).

See also In re Stempel, 241 F.2d 755, 760, 113 USPQ 77, 81 (C.C.P.A. 1957)(“What is a reference? It is nothing more than a patent or publication cited to show that all or part of the invention for which a patent is sought was in the prior art. . . .”)(citations omitted).

Thus, to permit the use of multiple References A, B and C as setting forth inherent characteristics of a primary reference, it thus follows that the primary reference *must be a document disclosing the Building Design Advisor software system*, not the software product itself. This interpretation in applying multiple references is supported by the Federal Circuit in *Continental Can Co. USA v. Monsanto Co.*:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, [a] gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in *the thing* [i.e., the BDA software product] *described in the reference* [i.e. primary printed publication or document]. . . .

20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)(emphasis added); see also M.P.E.P. §2112 (III).

Applicants respectfully note that nowhere does the Office Action indicate that one of the printed publication references A, B or C is to be considered a primary reference, with the remaining references cited to show that a characteristic not disclosed in the primary reference is inherent. Thus, no proper printed publication or patent is provided that “provides a gap to be filled” by the multiple References A, B and C.

A withdrawal of the rejection of the claims is thus respectfully requested. If the Examiner seeks to use the “Building Design Advisor (BDA) software system” as a 102(b)

reference, the Examiner is respectfully invited to provide an enabling printed publication or patent reference disclosing the software system such that the References A, B and C may be utilized in compliance with the M.P.E.P. in support of any inherency argument.

B. The Anticipation Rejections are Improper because, in Not Citing a Proper Primary Reference Disclosing the BDA Software Product, the Reference Date of the “Software Product” Cited within the Action is De Facto Indeterminate

In citing the “Building Design Advisor (BDA) software product” itself as a prior art reference, and not citing it as disclosed in a dated printed publication or patent as required by 35 U.S.C. 102(b), the Examiner has de facto not provided a publication date or patent date of the “product” such that a proper comparison has been made between the Applicant’s claimed invention and the reference. See M.P.E.P. §706.02(a) I (“Once the examiner conducts a search and finds a printed publication or patent which discloses the claimed invention . . . [t]he examiner must determine *the issue or publication date of the reference* so that a proper comparison between the application and reference dates can be made.”)(emphasis added).

A withdrawal of the rejection of the claims is thus respectfully requested. If the Examiner seeks to use the “Building Design Advisor (BDA) software product” as a 102(b) reference, the Examiner is respectfully invited to provide an enabling printed publication or patent reference disclosing the software system such the date of the reference can be determined in support of the anticipation rejections.

C. The Anticipation Rejections are Improper because, in Not Citing a Proper Primary Reference Disclosing the BDA Software Product, the “Version” of the “Software

Product” Cited within the Action is De Facto Indeterminate

The Papamichael References A, B and C each discuss present and future “versions” of the Building Design Advisor, with such present and future versions exhibiting different features or capabilities of the system. (See, e.g., Reference A: p. 1, para.3; p. 4, Fig. 1 & para. 1; pp. 13-14); (See, e.g., Reference B, p. 9, col. 2; p. 12, col. 1, para. 2; p. 13, cols. 1-2); (See, e.g., Reference C: p. 6, Fig. 2; pp. 13-14; p. 15, col. 1, para. 4). Although the Examiner asserts that the Papamichael References A, B and C disclose features or characteristics inherent in the “BDA software product,” the Examiner, in not providing a proper publication or patent reference disclosing the product, has de facto not recited a version number of the product such that the References A, B or C can be unambiguously applied. See 37 CFR §1.104(c)(2); M.P.E.P. §706. Thus, in absence of the primary publication or patent reference disclosing the BDA “software product,” the Examiner has not provided a prima facie determination of whether or not the “software product” is the version having the inherent features or capabilities as allegedly disclosed in the References A, B and C.

A withdrawal of the rejection of the claims is thus respectfully requested. In support of his anticipation rejections on the basis of inherency, the Examiner is thus respectfully invited to, in addition to citing a proper primary reference as discussed *supra*, provide a version number of the BDA reference such that a proper determination of inherency is unambiguously supported in view of the References A, B and C.

D. Even if a Proper Primary Reference was Provided, the Anticipation Rejections Would Nonetheless be Improper because No Rationale or Evidence is Provided Tending to

Show Inherency

With regard to the Examiner's statements in Section 7 of the Action and in support of each claim rejection relating to the combined use of the multiple Papamichael References A, B, and C as disclosing *inherent* features of the Building Design Advisor software product, the Applicants accept such statements as admissions that the references, taken alone or in combination, do not constitute the Building Design Advisor software product per se, nor do they expressly teach the Applicants' claimed invention. With further regard to the Examiner's assertions of inherency, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. M.P.E.P. §2112, IV (citations omitted). "In relying upon the theory of inherency, the [E]xaminer must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Id.* In support of his anticipation rejections on the basis of inherency, the Examiner broadly recites to various page and line and/or paragraph numbers of the multiple References A, B and/or C, while occasionally quoting excerpts selections from those references as allegedly disclosing an inherent characteristic taught by the "primary reference." However, nowhere does Section 9 of the Office Action, as called for by the M.P.E.P., provide a basis in fact and/or any technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art.

For example, in support of an argument that reference A discloses inherent characteristics relating to Applicants' claim 1 limitation of "selecting a set of items based on the calculated set

values,” the Office Action broadly recites “reference A: Last Paragraph, Page 2” (Office Action, Sections 7 and 9, pp. 10 and 18) without providing any basis in fact and/or technical reasoning to support the Examiner’s determination that the alleged inherent characteristic disclosed therein necessarily flows therefrom, as called for by the M.P.E.P. See M.P.E.P. §2112, IV (citations omitted).

As a further example, where the Examiner has provided a quoted excerpt from p. 12 of Reference A in support of his argument that reference A again discloses inherent characteristics relating to the “selecting” limitation of claim 1, the Office Action (Sections 7 and 9, pp. 11 & 18) recites that the “DVS selects a default exterior wall segment type by first computing the ASHRAE recommended minimal thermal resistance based on degree-days and then selecting a wall type from the library or [sic] walls that best matches the recommended value.” Again, however, the Examiner has provided no basis in fact and/or technical reasoning to reasonably support his determination that the allegedly inherent characteristic necessarily flows from the teachings of this excerpt. Such a basis in fact and/or technical reasoning could explain to the Applicants how the DVS, which selects “default values” as *input* to the simulation tools linked to the BDA (see Reference A, p. 12), inherently discloses the “selecting” limitation of claim 1, which selects a set of items based on calculated set values.

Furthermore, Applicants note that the Examiner cites this same excerpt (i.e., “the DVS excerpt”) in support of his argument that reference A discloses inherent characteristics relating to the “determining” limitation of claim 1 as well (Office Action, Section 9, pp. 17-18). Again, however, the Examiner has provided no basis in fact and/or technical reasoning to reasonably

support his determination that the allegedly inherent characteristic necessarily flows from the teachings of this excerpt, nor any explanation of why or how the excerpt discloses inherent characteristics relating to both claim limitations as well (i.e. relating to both the “determining” and “selecting” limitations of claim 1).

It is respectfully noted the lack of any basis in fact or technical reasoning illustrated by the foregoing examples occurs for each rejection recited throughout at least Section 9 of the Office Action, to include rejections for claim 33 and for claims directly or indirectly depending respectively from claims 1 and 33. For example, in support of the Rejection of claim 2, the Examiner has provided no basis in fact and/or technical reasoning to reasonably support his determination that the allegedly inherent characteristics relating to associated first and second item values necessarily flows from the teachings of the excerpts pertaining to the various databases cited. (See Office Action, Sections 7 and 9, pp. 12 and 22).

A withdrawal of the rejections of the claims is thus respectfully requested. In support of his anticipation rejections on the basis of inherency, the Examiner is thus respectfully invited to, in addition to citing a proper primary reference as discussed *supra*, provide any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art.

E. The Anticipation Rejections are Improper Because No Incorporation by
Reference of Any of References A, B or C is Present

Applicants note the Examiner’s statements within Section 7 of the Action that Papamichael was a common author of the References A, B and C, that reference A is cited in the

bibliography of reference B, that each reference was funded by the California Institute for Energy Efficiency, and that each reference was written at the Lawrence Berkeley National Laboratory in Berkeley, California.

If the Examiner sets forth such statements in support of an assertion that one or more of the references A, B or C incorporate one or more of the other references therein (i.e., in an attempt to integrate material from one or more of the references into a host or primary reference), applicants respectfully submit that such statements do not satisfy the Federal Circuit's requirement that the host reference both identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various other references. *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 54 U.S.P.Q.2d 1673, 1679 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 904 (2001).

A withdrawal of the rejection of the claims is thus respectfully requested. The Examiner is respectfully invited to provide a host or primary reference that properly incorporates one or more of the References A, B or C as recognized by the Federal Circuit.

In view of the foregoing, a withdrawal of the rejection of claim 1, and of claims 2, 7, 13, 14, 17, 18, 25, 30, 31, 82, 84 and 85 as directly or indirectly depending therefrom, is thus respectfully requested. A withdrawal of the rejection of claim 33, and of claims 42 and 89 as directly depending therefrom, is respectfully requested as well.

III. Assuming, arguendo, that the Examiner's anticipation rejections are proper, the anticipation rejections of the foregoing claims are unwarranted and thus traversed where

the multiple references fail to teach every element of the Applicants' claims that are allegedly inherent in the Building Design Advisor.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference.” M.P.E.P. § 2131 (*citing Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987))(emphasis added). Again, with regard to the Examiner's statements in Section 7 of the Action and in support of each claim rejection relating to the combined use of the multiple Papamichael References A, B, and C as disclosing inherent features of the Building Design Advisor software product, the Applicants accept such statements as admissions that the references, taken alone or in combination, do not constitute the Building Design Advisor software product per se, nor do they expressly teach the Applicants' claimed invention.

With regard to the Examiner's assertions that the multiple Papamichael References A, B and C disclose inherent features of the Building Design Advisor that read on each element of at least claims 1 and 33, the Applicants respectfully disagree. Exemplary embodiments of the Applicants' computer-implemented method of selecting items for a project within a criteria include the steps of:

- inputting project information, including project criteria;
- determining, with a computer, sets of items based on the project information that meet the criteria;
- calculating for each set of items a set value;
- selecting a set of items based on the calculated set values; and

displaying to a user the selected set of items that meet the project criteria.

Exemplary embodiments of the Applicants' system for selecting a set of items that meet a given criteria include the components of :

a central computer having a processor and an input device for receiving information on a project;

at least one database having a list of items that may be used in constructing the project and a first value for each of the items;

code for determining sets of items that may be used in constructing the project;

code for calculating a total first values for each set of items;

code for selecting a set of items based on the calculated total first values; and

code for displaying to a user the selected set of items.

With regard to at least claims 1 and 33, both the cited portions and the non-cited portions of references fail to teach or suggest that each of the enumerated steps of the claimed method is inherent in the Building Design Advisor. In contradistinction, the References A, B and C teach that *the designer, not the BDA*, selects a set of items that satisfy a set of values, which is evidenced as follows:

“The Desktop allows *building designers* to compare multiple design alternatives with respect to multiple descriptive and performance parameters . . .”
(*Reference A*, p. 1, para. 2)(emphasis added).

“Through its graphical user-interface, the core program allows *users* to . . . review results from computations and data queries in a variety of graphical displays.”
(*Id.* at p. 3, para. 3)(emphasis added).

“The main objectives of the GUI design were to allow *building designers* to . . . compare many alternative building designs with respect to many descriptive and performance parameters.”
(*Id.* at p. 6, para. 4)(emphasis added).

“The Decision Desktop allows *the user to compare multiple alternative designs* with respect to any number of input and output parameters addressed by the simulation tools linked to the BDA.”
(*Id.* at p. 7, caption to fig. 3)(emphasis added).

“Since performance evaluation requires comparison among alternatives [by building designers], we support the evaluation of concurrent design solutions. . . . The Decision Desktop allows multi-criterion decision-making [by building designers], through comparison of multiple alternative design solutions with respect to multiple performance parameters.”
(*Reference B*, p. 5, col. 1, paras. 1-2).

“To satisfy the need for performance evaluation, the BDA supports multiple design alternatives within a project database. . . . The BDA user interface supports the concurrent review and manipulation of any number of alternative design solutions. . . . Moreover, it supports their side-by-side comparison [by users] with respect to multiple performance considerations.”
(*Id.* at p. 9, col. 1, para. 1).

Performance prediction is mandatory, but not adequate for decision-making. Once performance has been predicted, it has to be evaluated with respect to its goodness or appropriateness. Since ‘good’ or ‘bad’ makes sense only when there are at least two of a kind, *evaluation requires comparison of multiple alternative design schemes....While performance prediction can be highly automated through the use of computers, performance evaluation cannot*, unless it is with respect to a single criterion. *The multi-criterion nature of most design decisions requires the direct involvement of humans.*
(*Reference C*, p. 3, col. 1, paras. 2-3)(emphasis added).

The need to also address performance aspects such as comfort, cost, aesthetics, etc., *require a multi-criterion judgment, which cannot be specified and delegated to others, let alone machines. Decision-making is the main non-delegable design task and can only be addressed by the designers themselves.* Moreover, it can only be addressed *through direct, side-by-side comparison of multiple design alternatives.* With the exception of this type of multi-criterion optimization, the rest of the design tasks can be specified and delegated to others, especially computers. . . . This recognition has been the basis for the development of the BDA software, in an attempt to . . . assist decision-makers with the parts of the design process that requires human judgment.
(*Id.* at p. 5, col. 1, paras. 1-2)(emphasis added).

“The Decision Desktop is a matrix that facilitates the comparison [by designers] of multiple design solutions with respect to multiple parameters.”
(*Id.* at p. 9, col. 2, para. 2).

“The Decision Desktop allows *designers to compare* multiple design solutions with respect to multiple descriptive and performance characteristics.”
(*Id.* at p. 11, fig. 10, caption)(emphasis added).

The references thus teach that the BDA, instead of selecting a set of items that satisfy a set of values or having code that selects the items, merely displays multiple design solutions for

comparison *by the designer* in making his/her design choices.

In response to the Examiner's specific recitations, the Applicants respectfully submit that the cited portions of the references do not inherently teach or suggest at least the "selecting" limitations of claims 1 and 33. For example, nowhere do the cited or non-cited portions of the references teach or suggest "selecting a set of items based on the calculated set values" or "code for selecting a set of items based on the calculated total first values." For Example, the Office Action (Sections 7 and 9, pp. 11 & 18) recites that the "DVS" from p. 12 of Reference A and pp. 8 & 14 of Reference C discloses allegedly inherent characteristics relating to the "selecting" limitation of claims 1 and 33. However, the DVS selects "default values" (i.e., aspects of the building description not addressed by the user) as *input* to the simulation tools linked to the BDA (see Reference A, p. 12) and not a set of items based on calculated set values.

Furthermore, p. 14 of Reference C recites future versions of the DVS, which is not enabling. (See, Response, Sections 8-9 II(C), *supra* and Section 8-9 II (IV), *infra*). Also, Applicants note that the Examiner uses the same citations from References A and C relating to the "DVS" in support of his arguments that they discloses inherent characteristics relating to the "determining" limitation of claims 1 and 33 as well (Office Action, Section 9, pp. 17-18 and 25-26). The Examiner is thus invited to explain how or why the "DVS" discloses both the "determining" and "selecting" limitations of claims 1 and 33.

With regard to the Examiner's remaining citations to References A and B as allegedly inherently disclosing the "selecting" limitation of claims 1 and 33, Applicants respectfully submit that the overly-broad nature of the citations creates difficulty in determining what part of

the cited documents support the rejection. For example, the Examiner cites to “Reference A: ‘The Decision Desktop,’ Pages 7-8” and “Reference B: ‘The building model,’ Pages 9-10.” (Office Action, Section 9, pp. 18-19). Thus, in presenting any assertion of inherency, the Examiner is respectfully invited to point to the *page and line no.* of the prior art that justifies the rejection. *See Ex parte Schricker*, 56 U.S.P.Q.2d 1723, 1725 (B.P.A.I. 2000)(“The examiner has left the applicant and the board to guess at the basis of the rejection . . . and what part of which document supports the rejection. . . [w]e decline to guess”)(unpublished).

From the Applicants’ interpretation of the foregoing citations to References A and B, it appears that the Examiner is citing the “Decision Desktop” against the Applicants’ “selecting” limitations of claims 1 and 33. However, in contradistinction to the “selecting” limitations and as discussed above, the Decision Desktop has *the designer, not the BDA itself*, select a set of items that satisfy a set of values. (E.g., Reference A: p. 1, para. 2)(“The Desktop allows building designers to compare multiple design alternatives with respect to multiple descriptive and performance parameters addressed by tools linked to the BDA.”).

With regard to the other foregoing citations to References A and B, Applicants respectfully submit that the activity relating to “selected” as recited by the references does not anticipate the “selecting” claim limitations of claims 1 and 33. For example, the Examiner cites to pp. 10-11 of Reference A which discloses the following:

Any number of input and output parameters can be *selected* by the user simply by clicking on the check-box to the left of them (Figure 5). . . . Once one or more of the performance parameters have been *selected* for viewing in the desktop, the user can request the computation and display of the values for all checked parameters by clicking on the “Calculate” button found in the main BDA window.

(Reference A, pp. 10-11)(emphasis added). However, input and output parameters selected by

the user for viewing on the desktop of the BDA, is not the same as “selecting a set of items based on calculated set values” (claim 1) or code relating to the same (claim 33). *See In re Chiang*, Civ. App. No. 94-1144, slip op. at 5 (Fed. Cir. Nov. 23, 1994)(stating that the claim limitation “calculating” cannot be reasonably interpreted to read on a reference that does not show such a calculation)(unpublished). If the Examiner opines that Applicants are incorrect in their analysis of the Examiner’s recitation, the Examiner is again respectfully invited to provide further specificity in his recitations to the references as discussed above, or to provide any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art. (See Response, Sections 8-9 II (D), *supra*).

Furthermore, in response to the Examiner’s statements regarding “automatically selecting,” the Applicants note that claim 1 expressly recites “A computer-implemented method of selecting items . . . comprising the steps of . . . selecting a set of items based on the calculated set values” while claim 33 expressly recites “A system for selecting a set of items . . . comprising . . . code for selecting a set of items based on the calculated total first values.” In contradistinction, the Papamichael References A, B and C, do not disclose that the BDA software product inherently performs at least this limitation or inherently has related code that performs the limitation, but instead expressly discloses that the limitation is performed by the designer, not the BDA itself. Because the Papamichael References A, B and C, taken alone or in combination, do not teach or suggest inherent features of the Building Design Advisor that read on every element of at least claims 1 and 33, claims 1 and 33 patentably distinguish over these

references and anticipation cannot be found.

With regard to the Examiner's recitation of *In re Venner*, 120 U.S.P.Q. 192, that "it is well settled that it is not 'invention' to broadly provide a mechanical or automatic means to replace a manual activity which has accomplished the same result," Applicants respectfully submit that the recitation supports the rationale for an obviousness rejection under 35 U.S.C. §103 and has no bearing on an anticipation analysis. *See In re Venner*, 262 F.2d 91, 120 U.S.P.Q. 192 (C.C.P.A. 1958); (See also M.P.E.P. §2144.04 et seq.) Furthermore, the Federal Circuit has held that a manual method does not anticipate an automatic method. *E.g., Systemation, Inc. v. Engel Indus, Inc.*, Civ. App. No. 98-1489 at *14 (Fed. Cir. Mar. 10, 1999)(unpublished).

It thus follows that the BDA displays "alternative designs" for comparison by the user, not the "selected set of items that meet the project criteria" or "code for displaying to a user the selected set of items," as called recited respectively by claims 1 and 33. (See Reference A, p. 7, fig. 3 and caption); (see Reference B, p. 5, col. 1, paras. 1-2) and (see Reference C, p. 9, col. 2, para. 2; p. 11, fig. 10, caption).

In view of the foregoing, a withdrawal of the rejection of claim 1, and of claims 2, 7, 13, 14, 17, 18, 25, 30, 31, 82, 84 and 85 as directly or indirectly depending therefrom, is thus respectfully requested. A withdrawal of the rejection of claim 33, and of claims 42 and 89 as directly depending therefrom, is respectfully requested as well.

IV. Assuming, arguendo, that the Examiner's anticipation rejections are proper, the

anticipation rejections of the foregoing claims are unwarranted and thus traversed where at least the multiple References A, B and C are not enabling.

A claim is anticipated only if each and every element, as arranged in the claim, is found in a prior art reference. M.P.E.P. §2131 (citations omitted). The prior art reference must describe and enable the claimed invention, *including all claim limitations*, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention. *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002)(emphasis added). Such description of the claimed invention must place the public in possession of it. *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 665, 231 U.S.P.Q. 649, 653 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 933 (1987). It is insufficient to merely name or describe the desired subject matter, if it cannot be produced without undue experimentation. *Elan Pharms., Inc. v. Mayo Found. for Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 U.S.P.Q.2d 1373, 1376 (Fed. Cir. 2003). If the allegedly anticipatory disclosures cited as prior art are not enabling, a claimed invention cannot be anticipated by the prior art reference.

Assuming, arguendo, that the Examiner's anticipation rejections are proper, Applicants respectfully submit that the Papamichael References A, B and C are not enabling because they merely describe various features of the Building Design Advisor without the clarity and detail necessary to establish that the subject matter already existed in the prior art, without undue experimentation. The vague and general descriptions therein do not enable one of ordinary skill

in the art to have possession of the invention, much less comprehend it.

The insufficient clarity of the references is compounded by discussions of various “versions” of the allegedly anticipating Building Design Advisor, with such versions each setting forth different features or capabilities of the system. (See Response, Sections 8-9, II (C), *supra*).

The various versions and their associated features create difficulties in determining what subject matter was already in existence prior to Applicant’s date of invention. *See Id.* Further confusion and uncertainty also results from the inconsistent pagination of Reference B. (See, Response, Sections 8-9, I, *supra*).

Because for at least the foregoing reasons the Papamichael References A, B and C are not enabling, anticipation cannot be found. In view of the foregoing, a withdrawal of the rejection of claim 1, and of claims 2, 7, 13, 14, 17, 18, 25, 30, 31, 82, 84 and 85 as directly or indirectly depending therefrom, is thus respectfully requested. A withdrawal of the rejection of claim 33, and of claims 42 and 89 as directly depending therefrom, is respectfully requested as well.

10-11. 35 U.S.C. §103(a) obviousness rejections (claim 80)

Claim 80 stands rejected under 35 U.S.C. §103(a) as unpatentable over the “Building Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” References A, B and C as applied to claims 1-2 and further in view of Official Notice.

The rejection of claim 80 under §103(a) as unpatentable over allegedly inherent features disclosed in References A, B and C in view of Official Notice is not warranted and is hereby

traversed. To establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580, 582 (C.C.P.A. 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art. *Id.* (*citing In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Applicants respectfully submit that the Examiner has not established *prima facie obviousness*. The portions of the Office Action in support of the rejection of claim 80 fails to address each element of at least claims 1 and 2, from which claim 80 depends, as called for by M.P.E.P. §706.02(j) in support of the rejection of these claims.

Assuming, *arguendo*, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claims, the inherency anticipation rejection of claim 2 is nonetheless inadequately supported therein while the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “selecting” limitation of claim 1. (See Response, Sections 8-9, II (D) and III, *supra*). Thus, where References A, B, and C alone or in combination, fail teach or suggest the aforementioned limitation, claim 80, read respectively with all of the limitations of at least claim 1, does not define obvious subject matter, regardless of whether or not the added limitations of the dependent claim are taught therein. *See In re Royka and Martin*, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974). In contradistinction, with regard to the “selecting” limitation of claim 1, the References A, B and C teach that *the designer, not the BDA*, selects a set of items that satisfy a set of values. (See Response, Sections 8-9, III, *supra*).

Applicants thus respectfully submit that these references teach away from the claimed

invention. *See In re Gurley*, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994)(a reference teaches away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant); *see also In re Caldwell*, 138 U.S.P.Q. 243, 246 (C.C.P.A. 1963)(reference teaches away if it leaves the impression that that the product would not have the property sought by applicant). The fact that the references teach away from the claimed invention is a factor to be considered against a finding to combine or modify them. *See* M.P.E.P. §2141.02(VI)(citations omitted).

Applicants note that the Examiner has rejected claim 80 in view of Official Notice, with such notice supported with recitation to a 1986 dissertation by William Leslie Carroll entitled "Energy and Optimization of Conduction-Dominated Buildings." Using such notice, the Examiner asserts that "[i]t would have been obvious to one skilled in the art at the time of the invention that the system and method for selecting items for a project within criteria including costs/economics as taught by the BDA would have benefited from enabling users to define budget constraints for the project including but not limited to energy budgets in view of the teachings of official notice."

However, Applicants respectfully submit that the Examiner has not cited to any suggestion or motivation in any of the references promoting such a combination, nor has the Examiner provided any reasoning or explanation as to why one of ordinary skill in the art at the time of the invention would have been motivated to make the proposed modification. *See, e.g.,* M.P.E.P. §706.02(j). The Applicants thus requests that the Examiner further specify the necessary information. A withdrawal of the rejection is respectfully requested.

Furthermore, Applicants note that, in citing to Official Notice as supported by the Carroll reference, the Examiner has not cited to any reference defining the level of ordinary skill in the art. The Applicants thus respectfully request that the Examiner provide a reference defining the ordinary skill in the art of an affidavit swearing to the same.

12. 35 U.S.C. §103(a) obviousness rejections (claims 3-6, 10-12, 15-16, 19-24, 26, 35 and 80-81)

Claims 3-6, 10-12, 15-16, 19-24, 26, 35 and 80-81 stand rejected under 35 U.S.C. §103(a) as unpatentable over the “Building Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” References A, B and C as applied to claims “1-2, 7, 13-14, 17-18, 25, 30-31, 33, 42, 82, 84-85 and 89” [sic] and further in view of MECcheck Software User’s Guide Version 3.0. Applicants note that although the Examiner has cited the references in view of claims 7, 13-14, 17-18, 25, 30-31, 42, 82, 84-85 and 89, the claims depend from 1, 2 and 33, respectively, not the claims as recited by the Examiner. The rejection of claims 3-6, 10-12, 15-16, 19-24, 26, 35 and 80-81 is unwarranted and is hereby traversed.

Claims 3, 12, 15 and 80:

Claims 3, 12, 15 and 80 stand rejected under 35 U.S.C. §103(a) as unpatentable over the BDA as evidenced by References A, B and C as applied to claims 1 and 2 and further in view of MECcheck software User’s Guide Version 3.0.

The rejection of claims 3, 12 and 15 under §103(a) as unpatentable over References A, B and C in view of MECcheck is not warranted and is hereby traversed. To establish *prima facie*

obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580, 582 (C.C.P.A. 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art. *Id.* (*citing In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Applicants respectfully submit that the Examiner has not established *prima facie* obviousness. The portions of the Office Action in support of the rejection of claims 3, 12 and 15 fail to address each element of claim 1, from which claim 15 depends, or of claims 1 and 2, from which claims 3 and 12 depend, as called for by M.P.E.P. §706.02(j) in support of the rejection of these claims.

Assuming, *arguendo*, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claims, the inherency anticipation rejection of claim 2 is nonetheless inadequately supported therein while the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “selecting” limitation of claim 1. (See Response, Sections 8-9, II (D) and III, *supra*). In contradistinction, with regard to the “selecting” limitation of claim 1, the References A, B and C teach that *the designer, not the BDA*, selects a set of items that satisfy a set of values. (See Response, Sections 8-9, III, *supra*).

Nor does MECcheck, alone or in combination, teach or suggest at least this limitation. In contradistinction, the MECcheck Software User’s Guide teaches that “[t]he software enables *you* [i.e. the designer] to quickly compare different insulation levels in different parts of your building to arrive at a package that works best for you.” (MECcheck, Software User’s Guide, p.1, para. 3)(emphasis added).

Applicants thus respectfully submit that these references teach away from the claimed invention. *See In re Gurley*, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994)(a reference teaches away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant); *see also In re Caldwell*, 138 U.S.P.Q. 243, 246 (C.C.P.A. 1963)(reference teaches away if it leaves the impression that that the product would not have the property sought by applicant). The fact that the references teach away from the claimed invention is a factor to be considered against a finding to combine or modify them. *See* M.P.E.P. §2141.02(VI)(citations omitted).

Thus, where neither References A, B, and C nor MECcheck, alone or in combination, teach or suggest the aforementioned limitation, claims 3, 12 and 15, read respectively with all of the limitations of claim 1 or claims 1 and 2, do not define obvious subject matter, regardless of whether or not the added limitations of each dependent claim are taught therein. *See In re Royka and Martin*, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974). Because claims 3, 12 and 15 are patentably distinguishable from the prior art, the withdrawal of the rejection of these claims is respectfully requested. Furthermore, because claims 3 and 12 directly depend from improperly-rejected claim 2 (*see Response*, Sections 8-9, II (D), *supra*) the withdrawal of the rejection of these claims is respectfully requested for this reason as well.

Applicants note that no support whatsoever is given within Section 12 of the Office Action for the rejection of claim 80. A withdrawal of the rejection of claim 80 is thus respectfully requested.

Claims 4, 5, 6, 10, 11, 16, 19, 20, 21, 22, 23, 24, 26 and 81 directly or indirectly depend

from claim 3 and include all of the limitations of that claim plus additional limitations.

Therefore, for at least the reasons set forth above in support of the non-obviousness of claim 3, Applicants respectfully submit that these claims are patentably distinguishable over the cited references as well. If a parent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious. See M.P.E.P. §2143.03(citing *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)). The withdrawal of the rejection of these claims is thus respectfully requested.

Claim 35

Claim 35 stands rejected under 35 U.S.C. §103(a) as unpatentable over the “Building Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” References A, B and C as applied to claim 33 and further in view of MECcheck Software User’s Guide Version 3.0.

The rejection of claim 35 over References A, B and C in view of MECcheck is not warranted and is hereby traversed. To establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing *In re Royka and Martin*, 180 U.S.P.Q. 580, 582 (C.C.P.A. 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art. *Id.* (citing *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Again, Applicants respectfully submit that the Examiner has not established *prima facie* obviousness. The portions of the Office Action in support of the rejection of claim 35 fail to address each element of claim 33, from which claim 35 depends as called for by M.P.E.P. §706.02(j) in support of the rejection of this claim.

Assuming, arguendo, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claim, the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “code for selecting” limitation of claim 33. (See Response, Sections 8-9, III, *supra*). In contradistinction, with regard to the “code for selecting” limitation of claim 33, the References A, B and C teach that *the designer, not the BDA*, selects a set of items that satisfy a set of values. *Id.*

Nor does the MECcheck reference, alone or in combination, teach or suggest at least this limitation, with the reference instead again teaching away from the claimed invention. (See Response, Section 12, *supra*). Again, the fact that the references teach away from the claimed invention is a factor to be considered against a finding to combine or modify them. *See* M.P.E.P. §2141.02(VI)(citations omitted).

Thus, where neither References A, B and C nor MECcheck, alone or in combination, teach or suggest this limitation, claim 35, read respectively with all of the limitations of claim 33, does not define obvious subject matter, regardless of whether or not the added limitations of each dependent claim are taught therein. *See In re Royka and Martin*, 180 U.S.P.Q. at 583. Because claim 35 is patentably distinguishable from the prior art, the withdrawal of the rejection of the claim is respectfully requested.

Applicants note that in rejecting the various claims within the present section, the Examiner repeatedly asserts that the recited inherent features of the BDA would have benefited from the recited features of the recited supplemental 103 references. However, Applicants respectfully submit that the Examiner has not cited to any suggestion or motivation in any of the

references promoting such a combination, nor has the Examiner provided any reasoning or explanation as to why one of ordinary skill in the art at the time of the invention would have been motivated to make the proposed modification. See, e.g., M.P.E.P. §706.02(j). The Applicants thus requests that the Examiner further specify the necessary information. A withdrawal of the rejection of the claims is respectfully requested.

13. 35 U.S.C §103(a) obviousness rejection (claims 8-9)

Claims 8 and 9 stand rejected under 35 U.S.C §103(a) as unpatentable over the “Building Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” References A, B and C as applied to claims 1 and 2 and further in view of An Expert System for Cost-Effective Energy Efficient Calculations by Maria Bosch (1996).

The rejection of claims 8 and 9 is not warranted and is hereby traversed. To establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580, 582 (C.C.P.A. 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art. *Id.* (*citing In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Applicants respectfully submit that the Examiner has not established *prima facie* obviousness. The portions of the Office Action in support of the rejection of claims 8 and 9 fail to address each element of claims 1 and 2, from which claims 8 and 9 directly or indirectly depend. For example, although the Office Action briefly discusses “selecting items,” nowhere

does the Action, as called for by M.P.E.P. §706.02(j) in support of the rejection, address where the remaining limitations of claim 1 or the “associated first item value and second item value” limitation of claim 2 are taught or suggested by the BDA as evidenced by References A, B and C, alone or in combination.

Assuming, arguendo, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claims, the inherency anticipation rejections of claim 2 are nonetheless inadequately supported therein while the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “selecting” limitation of claim 1. (See Response, Sections 8-9, II (D) and III, *supra*). In contradistinction, with regard to the “selecting” limitation of claim 1, the References A, B and C teach that *the designer, not the BDA*, selects a set of items that satisfy a set of values. (See Response, Sections 8-9, III, *supra*).

Nor does Bosch, alone or in combination, teach or suggest at least this limitation. In contradistinction and as acknowledged by the Examiner, Bosch teaches a system “that would help designers select the most appropriate and cost-effective combination of materials for their buildings.” (*Office Action*, Section 13, p. 52)(*citing* Bosch). Applicants thus respectfully submit that the cited references teach away from the claimed invention, with such teachings to be considered against a finding to combine or modify them. *See* M.P.E.P. §2141.02(VI)(citations omitted).

Thus, where neither References A, B and C nor Bosch, alone or in combination, teach or suggest the aforementioned limitation, claims 8 and 9, read respectively with all of the limitations of claims 1 and 2, do not define obvious subject matter, regardless of whether or not

the added limitations of each dependent claim are taught therein. *See In re Royka and Martin*, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974). Because claims 8 and 9 are patentably distinguishable from the prior art, the withdrawal of the rejection of these claims is respectfully requested. Furthermore, because claims 8 and 9 directly or indirectly depend from improperly-rejected claim 2 (*see Response*, Sections 8-9, II (D), *supra*), the withdrawal of the rejection of these claims is respectfully requested for this reason as well.

Applicants note that in rejecting the claims within the present section, the Examiner asserts that the recited inherent features of the BDA would have benefited from the recited features of the Bosch reference. However, Applicants respectfully submit that the Examiner has not cited to any suggestion or motivation in any of the references promoting such a combination, nor has the Examiner provided any reasoning or explanation as to why one of ordinary skill in the art at the time of the invention would have been motivated to make the proposed modification. See, e.g., M.P.E.P. §706.02(j). The Applicants thus requests that the Examiner further specify the necessary information. A withdrawal of the rejection of the claims is respectfully requested.

14. 35 U.S.C. §103(a) obviousness rejections (claims 27-28)

Claims 27 and 28 stand rejected under 35 U.S.C. §103(a) as unpatentable over the “Building Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” References A, B and C and in view of MECcheck as applied to claims 1-3 and further in view of Jung, U.S. Patent No.

6,996,503.

The rejection of claims 27 and 28 as unpatentable over References A, B and C in view of MECheck and in further view of Jung is not warranted and is hereby traversed. Applicants agree with the Examiner that neither the BDA, as evidenced in References A, B and C, nor MECcheck, teach “generating a bill of materials based on the selected set of items.” The Examiner thus relies on Jung as teaching this limitation.

Under 35 U.S.C. §103, prior art references must have an effective date prior to the Applicants’ date of invention, i.e., at least February 21, 2001, Applicants’ filing date. The Applicants note, however, that Jung does not qualify as prior art because its April 24, 2001 filing date does not pre-date that of the present application. Although Jung claims priority to a number of foreign patents, a U.S. patent application is not effective on the filing date of an earlier-filed foreign patent application under 35 U.S.C. §119. *In re. Hilmer*, 149 U.S.P.Q. 480, 496 (C.C.P.A. 1966).

The withdrawal of the rejection of claims 27 and 28 is thus respectfully requested. Upon examination of the Jung patent, Applicants note that one or more of the patent’s foreign priority documents may have publication dates possibly relevant to the examination of the present application. However, the Examiner has not cited any of these foreign priority documents, nor are the Applicants aware of their content.

Furthermore, to establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580, 582 (C.C.P.A. 1974)). “All words in a claim must be considered

in judging the patentability of that claim against the prior art. *Id.* (citing *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Applicants respectfully submit that, in addition to citing to the improper Jung reference, the Examiner has not established prima facie obviousness. The portions of the Office Action in support of the rejection of claims 27 and 28 fail to address each element of claims 1 and 2, from which claims depend, as called for by M.P.E.P. §706.02(j) in support of the rejection of these claims.

Assuming, arguendo, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claims, the inherency anticipation rejection of claim 2 is nonetheless inadequately supported therein while the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “selecting” limitation of claim 1. (See Response, Sections 8-9, II (D) and III, *supra*). In contradistinction, with regard to the “selecting” limitation of claim 1, the References A, B and C teach that *the designer, not the BDA*, selects a set of items that satisfy a set of values. (See Response, Sections 8-9, III, *supra*).

Nor does the MECcheck reference, alone or in combination, teach or suggest at least this limitation, with the reference instead again teaching away from the claimed invention. (See Response, Section 12, *supra*). Again, the fact that the references teach away from the claimed invention is a factor to be considered against a finding to combine or modify them. *See* M.P.E.P. §2141.02(VI)(citations omitted).

Thus, where neither References A, B, and C nor MECcheck, alone or in combination, teach or suggest the aforementioned limitation, claims 27 and 28, read respectively with all of

the limitations of claims 1 and 2, do not define obvious subject matter, regardless of whether or not the added limitations of each dependent claim are taught therein. *See In re Royka and Martin*, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974). Because claims 27 and 28 are patentably distinguishable from the prior art, the withdrawal of the rejection of these claims is respectfully requested. Furthermore, because claims 27 and 28 depend from improperly-rejected claim 2 (*see Response*, Sections 8-9, II (D), *supra*) the withdrawal of the rejection of these claims is respectfully requested for this reason as well. Applicants also note that claim 27 and 28 depend from claim 3 and include all of the limitations of that claim plus additional limitations. Therefore, also for at least the reasons set forth in Section 12 of this Response in support of the non-obviousness of claim 3, Applicants respectfully submit that claims 27 and 28 are patentably distinguishable over the cited references.

Assuming, *arguendo*, that Jung is a proper reference, Applicants note that in rejecting the claims within the present section, the Examiner asserts that the recited inherent features of the BDA and that the features of MECcheck would have benefited from the recited features of the Jung reference. However, Applicants respectfully submit that the Examiner has not cited to any suggestion or motivation in any of the references promoting such a combination, nor has the Examiner provided any reasoning or explanation as to why one of ordinary skill in the art at the time of the invention would have been motivated to make the proposed modification. *See, e.g., M.P.E.P. §706.02(j)*. The Applicants thus requests that the Examiner further specify the necessary information. A withdrawal of the rejection of the claims is respectfully requested.

15. 35 U.S.C. §103(a) obviousness rejection (claims 32, 86 and 88)

Claims 32, 86 and 88 stand rejected under 35 U.S.C. §103(a) as unpatentable over the “Building Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” References A, B and C as applied to claims 1-2 and further in view of Pray et al., U.S. Patent No. 4,885,694.

The rejection of claims 32, 86 and 88 under §103(a) as unpatentable over allegedly inherent features disclosed in References A, B and C in view of Pray is not warranted and is hereby traversed. To establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580, 582 (C.C.P.A. 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art. *Id.* (*citing In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Applicants respectfully submit that the Examiner has not established *prima facie* obviousness. The portions of the Office Action in support of the rejection of claims 32, 86 and 88 fail to address each element of claims 1 and 2, from which the claims depend, as called for by M.P.E.P. §706.02(j) in support of the rejection of these claims.

Assuming, *arguendo*, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claims, the inherency anticipation rejection of claim 2 is nonetheless inadequately supported therein while the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “selecting” limitation of claim 1. (See Response, Sections 8-9, II (D) and III, *supra*). In contradistinction, with regard to the

“selecting” limitation of claim 1, the References A, B and C teach that *the designer, not the BDA*, selects a set of items that satisfy a set of values. (See Response, Sections 8-9, III, *supra*). Nor does Pray, alone or in combination, teach or suggest at least this limitation.

Applicants thus respectfully submit that the References A, B and C teach away from the claimed invention. *See In re Gurley*, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994)(a reference teaches away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant); *see also In re Caldwell*, 138 U.S.P.Q. 243, 246 (C.C.P.A. 1963)(reference teaches away if it leaves the impression that that the product would not have the property sought by applicant). The fact that the references teach away from the claimed invention is a factor to be considered against a finding to combine or modify them. *See M.P.E.P.* §2141.02(VI)(citations omitted).

The withdrawal of the rejection of these claims is thus respectfully requested. Furthermore, because claims 86 and 88 indirectly depend from improperly-rejected claim 2 (see Response, Sections 8-9, II (D), *supra*), the withdrawal of the rejection of these claims is respectfully requested for this reason as well.

Applicants note that in rejecting the claims within the present section, the Examiner repeatedly asserts that the recited inherent features of the BDA would have benefited from the recited features of the Pray reference. However, Applicants respectfully submit that the Examiner has not cited to any suggestion or motivation in any of the references promoting such a combination, nor has the Examiner provided any reasoning or explanation as to why one of ordinary skill in the art at the time of the invention would have been motivated to make the

proposed modification. See, e.g., M.P.E.P. §706.02(j). The Applicants thus requests that the Examiner further specify the necessary information. A withdrawal of the rejection of the claims is respectfully requested.

16 35 U.S.C. §103(a) obviousness rejection (claim 87)

Claim 87 stands rejected under 35 U.S.C. §103(a) as unpatentable over the “Building Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” References A, B and C as applied to claims “32, 86 and 88” [sic] and further in view of Pray et al., U.S. Patent No. 4,885,694 and further in view of MECcheck. Applicants note that although the Examiner has cited the references in view of claims 86 and 88, claim 87 depends from claims 32, 2 and 1, not claims 86 and 88.

The rejection of claim 87 under §103(a) as unpatentable over allegedly inherent features disclosed in References A, B and C in view of Pray and MECcheck is not warranted and is hereby traversed. To establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580, 582 (C.C.P.A. 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art. *Id.* (*citing In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Applicants respectfully submit that the Examiner has not established *prima facie* obviousness. The portions of the Office Action in support of the rejection of claims 87 fail to address each element of claims 1 and 2, from which claim 87 depends, as called for by M.P.E.P.

§706.02(j) in support of the rejection of these claims.

Assuming, arguendo, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claims, the inherency anticipation rejection of claim 2 is nonetheless inadequately supported therein while the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “selecting” limitation of claim 1. (See Response, Sections 8-9, II (D) and III, *supra*). In contradistinction, with regard to the “selecting” limitation of claim 1, the References A, B and C teach that *the designer, not the BDA*, selects a set of items that satisfy a set of values. (See Response, Sections 8-9, III, *supra*). Nor does the MECcheck or Pray references, alone or in combination, teach or suggest at least this limitation, with the MECheck reference instead again teaching away from the claimed invention. (See Response, Section 12, *supra*). Again, the fact that the references teach away from the claimed invention is a factor to be considered against a finding to combine or modify them. See M.P.E.P. §2141.02(VI)(citations omitted).

Thus, where neither References A, B and C, nor the Pray or MECcheck references, alone or in combination, teach or suggest this limitation, claim 87, read respectively with all of the limitations of claims 1 and 2, does not define obvious subject matter, regardless of whether or not the added limitations of each dependent claim are taught therein. See *In re Royka and Martin*, 180 U.S.P.Q. at 583. Because claim 87 is patentably distinguishable from the prior art, the withdrawal of the rejection of the claim is respectfully requested. Furthermore, because claim 87 indirectly depends from improperly-rejected claim 2 (see Response, Sections 8-9, II (D), *supra*), the withdrawal of the rejection of these claims is respectfully requested for this

reason as well. Applicants also note that claim 87 directly depends from claim 32 and include all of the limitations of that claim plus additional limitations. Therefore, also for at least the reasons set forth in Section 15 of this Response in support of the non-obviousness of claim 32, Applicants respectfully submit that claim 87 is patentably distinguishable over the cited references.

Applicants further note that in rejecting the claims within the present section, the Examiner repeatedly asserts that the recited inherent features of the BDA and the features of Pray would have benefited from the recited features of the MECcheck reference. However, Applicants respectfully submit that the Examiner has not cited to any suggestion or motivation in any of the references promoting such a combination, nor has the Examiner provided any reasoning or explanation as to why one of ordinary skill in the art at the time of the invention would have been motivated to make the proposed modification. See, e.g., M.P.E.P. §706.02(j). The Applicants thus requests that the Examiner further specify the necessary information. A withdrawal of the rejection of the claims is respectfully requested.

17. 35 U.S.C. §103(a) obviousness rejections (claim 34)

Claim 34 stands rejected under 35 U.S.C. §103(a) as unpatentable over the “Building Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” References A, B and C as applied to claim 33 and further in view of Jung. The rejection of claim 34 as unpatentable over References A, B and C in view of Jung is not warranted and is hereby traversed.

Applicants agree with the Examiner that the BDA, as allegedly evidenced inherently in References A, B and C, do not teach “a total material cost as claimed.” The Examiner thus relies on Jung as teaching this limitation. However, as discussed in Section 14 of this Response, Jung does not qualify as prior art because its April 24, 2001 filing date does not pre-date that of the present application. The withdrawal of the rejection of claim 34 is thus respectfully requested.

Furthermore, to establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580, 582 (C.C.P.A. 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art. *Id.* (*citing In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Applicants respectfully submit that, in addition to citing to the improper Jung reference, the Examiner has not established *prima facie obviousness*. The portions of the Office Action in support of the rejection of claim 34 fail to address each element of claim 33, from which claim 34 depends as called for by M.P.E.P. §706.02(j) in support of the rejection of this claim.

Assuming, *arguendo*, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claim, the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “code for selecting” limitation of claim 33. (See Response, Sections 8-9, III, *supra*). In contradistinction, with regard to the “code for selecting” limitation of claim 33, the References A, B and C teach that *the designer, not the BDA*, selects a set of items that satisfy a set of values. *Id.*

Thus, where References A, B and C, alone or in combination, fail to teach or suggest this

limitation, claim 34, read respectively with all of the limitations of claim 33, does not define obvious subject matter, regardless of whether or not the added limitations of the dependent claim is taught therein. *See In re Royka and Martin*, 180 U.S.P.Q. at 583. Because claim 34 is patentably distinguishable from the prior art, the withdrawal of the rejection of the claim is respectfully requested.

Assuming, arguendo, that Jung is a proper reference, Applicants note that in rejecting the claims within the present section, the Examiner asserts that the recited inherent features of the BDA would have benefited from the recited features of the Jung reference. However, Applicants respectfully submit that the Examiner has not cited to any suggestion or motivation in any of the references promoting such a combination, nor has the Examiner provided any reasoning or explanation as to why one of ordinary skill in the art at the time of the invention would have been motivated to make the proposed modification. See, e.g., M.P.E.P. §706.02(j). The Applicants thus requests that the Examiner further specify the necessary information. A withdrawal of the rejection of the claims is respectfully requested.

18. 35 U.S.C. §103(a) obviousness rejection (claims 36-38, 43 and 83)

Claims 36-38, 43 and 83 stand rejected under 35 U.S.C. §103(a) as unpatentable over the “Building Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” References A, B and C and in view of Jung as applied to claims 33-34 and further in view of MECcheck. The rejection of claims 36-38, 43 and 83 as unpatentable over References A, B and C in view of Jung and in

further view of MECheck is not warranted and is hereby traversed.

Claims 36 and 83

Claims 36 and 83 stand rejected under 35 U.S.C. §103(a) as unpatentable over the “Building Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” References A, B and C in view of Jung as applied to claims 33 and 34 and further in view of MECcheck.

The rejection of claims 36 and 83 over References A, B and C in view of Jung and in further in view of MECheck is not warranted and is hereby traversed. As discussed in Section 14 of this Response, Jung does not qualify as prior art because its April 24, 2001 filing date does not pre-date that of the present application. Furthermore, to establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580, 582 (C.C.P.A. 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art. *Id.* (*citing In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Again, Applicants respectfully submit that the Examiner has not established *prima facie* obviousness. The portions of the Office Action in support of the rejection of claims 36 and 83 fail to address each element of claim 33, from which claims 36 and 83 depends as called for by M.P.E.P. §706.02(j) in support of the rejection of these claims.

Assuming, *arguendo*, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claim, the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “code for selecting” limitation of claim 33. (See

Response, Sections 8-9, III, *supra*). In contradistinction, with regard to the “code for selecting” limitation of claim 33, the References A, B and C teach that *the designer, not the BDA*, selects a set of items that satisfy a set of values. *Id.*

Nor does the MECcheck reference, alone or in combination, teach or suggest at least this limitation, with the reference instead again teaching away from the claimed invention. (See Response, Section 12, *supra*). Again, the fact that the references teach away from the claimed invention is a factor to be considered against a finding to combine or modify them. *See* M.P.E.P. §2141.02(VI)(citations omitted).

Thus, where neither References A, B and C nor MECcheck, alone or in combination, teach or suggest this limitation, claims 38 and 83, read respectively with all of the limitations of claim 33, do not define obvious subject matter, regardless of whether or not the added limitations of each dependent claim are taught therein. *See In re Royka and Martin*, 180 U.S.P.Q. at 583. Because claims 36 and 83 are patentably distinguishable from the prior art, the withdrawal of the rejection of the claims is respectfully requested.

Claims 37, 38 and 43 directly or indirectly depend from claim 36 and include all of the limitations of that claim plus additional limitations. Therefore, for at least the reasons set forth above in support of the non-obviousness of claim 36, Applicants respectfully submit that these claims are patentably distinguishable over the cited references as well. Applicants also note that claim 83 directly depends from claim 34 and include all of the limitations of that claim plus additional limitations. Therefore, also for at least the reasons set forth in Section 17 of this Response in support of the non-obviousness of claim 34, Applicants respectfully submit that

claim 83 is patentably distinguishable over the cited references.

Applicants note that in rejecting the various claims within the present section, the Examiner repeatedly asserts that the recited inherent features of the BDA would have benefited from the recited features of the recited supplemental 103 references. However, Applicants respectfully submit that the Examiner has not cited to any suggestion or motivation in any of the references promoting such a combination, nor has the Examiner provided any reasoning or explanation as to why one of ordinary skill in the art at the time of the invention would have been motivated to make the proposed modification. See, e.g., M.P.E.P. §706.02(j). The Applicants thus requests that the Examiner further specify the necessary information. A withdrawal of the rejection of the claims is respectfully requested

19 35 U.S.C. §103(a) obviousness rejection (claims 39-41)

Claims 39-41 stand rejected under 35 U.S.C. §103(a) as unpatentable over the “Building Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” References A, B and C and in view of Jung and MECcheck as applied to claims “34 and 26” [sic] and further in view of Bosch. Applicants note that although the Examiner has cited the references in view of claim 26, the claims depend from claims 36, 34 and 33, not claim 26.

The rejection of claims 39-41 under §103 as unpatentable over References A, B and C in view of Jung and MECcheck and further in view of Bosch is not warranted and is hereby traversed. As discussed in Section 14 of this Response, Jung does not qualify as prior art

because its April 24, 2001 filing date does not pre-date that of the present application.

Furthermore, to establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580, 582 (C.C.P.A. 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art. *Id.* (*citing In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Again, Applicants respectfully submit that the Examiner has not established *prima facie obviousness*. The portions of the Office Action in support of the rejection of claim 39-41 fail to address each element of claim 33, from which the claims indirectly depends as called for by M.P.E.P. §706.02(j) in support of the rejection of these claims.

Assuming, *arguendo*, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claim 33, the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “code for selecting” limitation of claim 33. (See Response, Sections 8-9, III, *supra*). In contradistinction, with regard to the “code for selecting” limitation of claim 33, the References A, B and C teach that *the designer, not the BDA*, selects a set of items that satisfy a set of values. *Id.*

Nor do the MECcheck or Bosch references, alone or in combination, teach or suggest at least this limitation, with the references instead again teaching away from the claimed invention. (See Response, Section 12 and 13, *supra*). Applicants thus respectfully submit that where the cited references teach away from the claimed invention, such teachings to be considered against a finding to combine or modify them. *Id.*

Thus, where neither the References A, B and C nor MECcheck or Bosch , alone or in combination, teach or suggest this limitation, claims 39-41, read respectively with all of the limitations of claim 33, does not define obvious subject matter, regardless of whether or not the added limitations of each dependent claim are taught therein. *See In re Royka and Martin*, 180 U.S.P.Q. at 583. Because claims 39-41 patentably distinguish from the prior art, the withdrawal of the rejection of the claims is respectfully requested. Applicants also note that claims 39-41 depend from claim 36 and include all of the limitations of that claim plus additional limitations. Therefore, also for at least the reasons set forth in Section 18 of this Response in support of the non-obviousness of claim 36, Applicants respectfully submit that claims 39-41 are patentably distinguishable over the cited references.

Applicants note that in rejecting the various claims within the present section, the Examiner repeatedly asserts that the recited inherent features of the BDA would have benefited from the recited features of the recited supplemental 103 references. However, Applicants respectfully submit that the Examiner has not cited to any suggestion or motivation in any of the references promoting such a combination, nor has the Examiner provided any reasoning or explanation as to why one of ordinary skill in the art at the time of the invention would have been motivated to make the proposed modification. See, e.g., M.P.E.P. §706.02(j). The Applicants thus requests that the Examiner further specify the necessary information. A withdrawal of the rejection of the claims is respectfully requested.

20 35 U.S.C. §103(a) obviousness rejection (claim 29)

Claim 29 stands rejected under 35 U.S.C. §103(a) as unpatentable over the “Building

Application. No. 09/788,470
Response to Office Action of July 11, 2006

Design Advisor (BDA) software product,” with the “features, capabilities and/or *characteristics inherent* in the BDA software product being disclosed in” References A, B and C in view of MECcheck and Jung as applied to claims 1-3 and 27-27 and further in view of Wares.

The rejection of claim 29 as unpatentable over References A, B and C in view of MECcheck and Jung and in further view of Wares is not warranted and is hereby traversed. Applicants agree with the Examiner’s finding that the BDA does not teach displaying information on suppliers based on the bill of materials. However, claim 29 directly depends from claim 27. As noted in Applicant’s arguments for the withdrawal of the rejection of claim 27, Jung does not qualify as prior art because it’s filing date does not pre-date that of the present application. The withdrawal of the rejection of claim 29 is thus respectfully requested as depending from an improperly rejected claim. Furthermore, because claim 29 indirectly depends from improperly-rejected claim 2 (see Response, Sections 8-9, II (D), *supra*), the withdrawal of the rejection of this claim is respectfully requested for this reason as well.

In conclusion, it is respectfully submitted, that none of the documents, alone or in combination, teach or suggest the claimed invention. The accompanying discussion is thus deemed to dispose of all issues in this case and to place this application in a condition for allowance. Early such action is solicited.

The prior art cited but not relied upon has been reviewed with interest. However, this prior art is not deemed to vitiate the patentability of the claimed invention.

Application. No. 09/788,470
Response to Office Action of July 11, 2006

Respectfully Submitted,

Dated: December 11, 2006

By: /Timothy G. Hofmeyer/
Timothy G. Hofmeyer
Registration No. 46,777
Attorney for Applicants

Johns Manville
10100 West Ute Avenue
P.O. Box 625005
Littleton, Colorado 80162-5005
(303) 978-2397 phone
(303) 978-2323 fax
Customer No. 29602